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EXAMINER

KARMIS, STEFANOS

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/698,310
Filing Date: October 27, 2000
Appellant(s): REBER, WILLIAM L.

Steven G. Parmelee
Registration No. 28,790
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 16 August 2006 and supplemental appeal brief filed on 22 September 2006 appealing from the Office action mailed 12 May 2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5,546,475	BOLLE ET AL	8-1996
6,530,521	HENRY	3-2003
6,483,570	SLATER ET AL	11-2002

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 1-11 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter because the claimed invention does not provide a practical application. Specifically the claimed invention lacks a tangible result. The test for tangibility lies in whether the claimed invention produces a real-world result. Claim 1 recites the following result, “facilitating a task associated with the at least one object based on the image and the task selection.” Further claim 11 recites, “wherein said facilitating the task comprises recognizing the at least one object in the image.”

It is the position of the Examiner that “facilitating the task comprising recognizing” is not a real-world result. As such the claimed invention fails to produce a tangible result and thus a lacks a practical application.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1,2,5,6,7,11,12,13,16,17,18,22,23,26,27,28 and 32 are rejected under 35 U.S.C.

103(a) as being unpatentable over Bolle et al in view of Henry.

Bolle teaches capturing an image of at least one object (see for example column 5, line 60 through column 6, line 6).

Bolle further teaches providing a menu of a plurality of object classes (see for example column 16 and column 19, line 61 through column 20, line 2).

Bolle further teaches receiving an object class selection from the menu (see for example column 20, lines 2 through 12).

Bolle does not specifically teach providing at least one task menu specific to the object class selection, receiving a task selection from the at least one task menu and facilitating a task associated with the at least one object based on the image and the task selection.

Henry teaches a produce recognition apparatus and method of obtaining information about produce items. Specifically Henry teaches after identification of produce providing a task menu specific to the object (produce), receiving a task selection from the at least one task menu and facilitating a task associated with the at least one object based on the image and the task selected (see for example column 1, lines 62-66 and column 2, line 51 through column 3, line 5). Henry teaches this is done in order to provide helpful information about produce items to a customer (see column 3, lines 4-5).

It would have been obvious to one of ordinary skill in the art to modify the produce recognition system of Bolle to include providing a task menu specific to the object (produce), receiving a task selection from the at least one task menu and facilitating a task associated with

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the at least one object based on the image and the task selected as taught by Henry. One of ordinary skill in the art would have been motivated to make said modification in order to provide helpful information about produce items to a customer.

5. Claims 3,4,8,9,10,14,15,19,20,21,24,25,29,30 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bolle in view of Henry and in further in view of Slater et al.

6. The combination of Bolle in view of Henry does not teach a person, company, location or event object class.

It is the position of the Examiner that image recognition is old and well known in the art. In fact particular image recognition techniques including content identification which includes the identification of one or more objects in a scene captured by an original image. Scene objects may include people, animals, plants, machinery and equipment. Examiner uses Slater as evidence of such old and well know technologies. (see for example column 5, lines 50-60).

Further the Examiner recognizes that the purpose of object recognition in Slater is to provide a picture taker with targeted advertising (see column 5, lines 9-20). However, as Henry teaches that a customer may desire additional information about a piece of produce, Examiner asserts takes Official Notice that it is old and well known in the art for a customer to desire more information about an object in a picture.

As such it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the combination of Bolle and Henry, in order to recognize scene objects via the image processing unit of Bolle and then provide the user with information (tasks)

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associated with the identified scene objects. One of ordinary skill in the art would have been motivated to combine the art provided in order to allow user to quickly ascertain information desired about an object as is old and well known in the art.

(10) Response to Argument

The Examiner summarizes the various points raised by the Appellant and addresses them individually.

A. Rejection of claims 1-11 under 35 U.S.C. § 101.

1. Regarding claims 1-11, Appellant argues that the rejection of claims 1-11 as being directed to non-statutory subject matter is improper (Appeal Brief, pages 6-8).

In Response: Applicant's arguments, with respect to the rejection under 35 U.S.C. § 101, have been fully considered and are persuasive. Therefore the rejection under 35 U.S.C. § 101 has been withdrawn.

B. Rejection of claims 1, 2, 5-7, 11-13, 16-18, 22, 23, 26-28, and 32 under 35 U.S.C. § 103(a) over Bolle in view of Henry.

2. Regarding independent claim 1, Appellant argues that the cited prior art fails to teach providing a menu of a plurality of object classes and providing at least one task menu specific to the object class selection and facilitating the task (Appeal Brief, pages 8-13).

In Response: The Examiner respectfully disagrees with the Appellant. First Appellant argues that Bolle fails to teach providing at least one task menu specific to the object class and

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facilitating the task. However, as stated in the final rejection, Bolle was no relied on for this teaching. Therefore this argument is moot. Instead, Bolle was cited for capturing an image of at least one object and providing a menu of a plurality of object classes and receiving an object class selection from the menu. Bolle teaches a plurality of object classes, including one or more apples, cereal boxes, red, green, yellow, brown, round, straight, leafy, citrus fruits, peppers and potatoes (column 7, lines 37-52 and column 19, lines 61 thru column 20, lines 12). Claim 1 fails to limit the interpretation of "object classes" and therefore the term has been given its broadest reasonable interpretation. Under the broadest reasonable interpretation, all the categories mentioned in Bolle can be considered object. Apples, cereal boxes, citrus fruit, peppers and potatoes are at least object classes consistent with Applicant's product class. Each item, would be a different object class. Therefore, apples are a different object class from peppers which are a different object class from potatoes, etc.

Continuing, Appellant argues that Henry fails to teach identifying objects in a plurality of object classes. Instead, Appellant asserts that because Henry's teachings are related to produce, that produce is the object class, and therefore there is only one object class instead of a plurality. However, such a narrow reading is not required. First, Bolle was relied on for the teachings of a plurality of object classes as discussed above. Nonetheless, Henry also teaches a plurality of object classes. Under the broadest reasonable interpretation, each produce item is an individual object class. While, Henry does not recite specific produce items, the items discussed in Bolle, apples, citrus fruits, peppers and potatoes, are items known to be produce items found in the produce isle. These items are all typically not labeled with barcodes and often times require

manual identification. Therefore, Henry teaches "object classes" in the plurality of produce items, such as the ones taught by Bolle.

Appellant also argues that Henry fails to teach providing at least one task menu specific to the object class, receiving a task selection from the at least one task menu and facilitating a task associated with the at least one object based on the image and the task selection. The Examiner respectfully disagrees. Appellant notes that tasks include for example, obtaining information about the product, learning how to perform various tasks that are associated with a given product, purchasing the product, and so forth (see appeal brief, page 5). Henry teaches that after the produce item has been identified, the system provides a task menu specific to the produce item in which the user can obtain recipe information, nutritional information, and other helpful information about produce item such as price checks (column 5, lines 11-33 and column 2, line 51 thru column 3, line 5). Clearly these tasks conform to the at least one task menu criteria stated by the Appellant, of obtaining information about the product, learning how to perform various tasks that are associated with a given product, purchasing the product. The tasks are specific because the recipe and nutritional information are specific to the produce item (i.e. apple, citrus fruit, potato, etc.). It does not matter that recipe information and nutritional information are tasks for all the produce items, because the information they provide varies based on the selected produce. Therefore, the task information is specific to the object class. Henry teaches that the information above, such as recipe information, nutritional information, and other helpful information can be elected and printed for the user (column 5, lines 11-33). Therefore, Henry also teaches receiving the task selection from the task menu and facilitating a task associated with the at least one object based on the image and the task selection.

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As stated in the office action, it would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify the produce recognition system of Bolle to include providing a task menu specific to the produce (object class), receiving a task selection from the at least one task menu and facilitating a task associated with the at least one object based on the image and the task selected as taught by Henry. There is sufficient motivation to combine the teachings of Bolle with the teachings of Henry because it provides helpful information about produce items (object classes) to a customer. Applicant's arguments against the combination are not persuasive. Bolle teaches recognizing the object and selecting the particular object (column 19, line 61 thru column 20, line 12; Examiner notes that apple can be selected). Therefore the object is clearly known when selected. Similarly, Henry teaches recognizing produce and identifying the specific produce item (column 4, line 66 thru 10). Therefore, there is sufficient teaching and motivation to combine the teachings of Bolle and Henry.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

For these reasons, claim 1 remains rejected under 35 U.S.C. § 103(a) over Bolle in view of Henry. Independent claim 1 is representative of the claims and arguments. Independent

claims 12 and 22 provide similar limitations of claim 1 and therefore are rejected based on the same reasoning discussed above for claim 1.

C. Rejection of claims 3, 4, 8-10, 14, 15, 19-21, 24, 25 and 29-31 under 35 U.S.C. § 103(a) over Bolle in view of Henry in further view of Slater.

3. Regarding dependent claim 3, Appellant argues that there is no motivation to combine the teachings of Slater with Bolle in view of Henry (Appeal Brief, pages 13-14).

In Response: The Examiner respectfully disagrees with the Appellant. First Examiner notes that Appellant argues against the motivation to combine the teachings. Therefore, there are no arguments that the cited prior art fails to teach the limitations of claim 3. Slater teaches a method of processing customer image orders and providing image content identification (Abstract and column 5, lines 50 thru column 6, line 49). In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). The Examiner submits that the teachings of Slater are analogous to the teachings of Bolle in view of Henry in that the teachings are centered around image identification of objects to provide a user with information and services based on the identification. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify the teachings of Bolle in view of Henry for image

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recognizing of objects (i.e. produce) to include recognizing of scene objects (i.e. people) because it provides the user with the ability to ascertain information quickly about a desired object.

For at least this reason, Appellant's arguments regarding claim 3 are not persuasive.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,
/Stefanos Karmis/
Examiner, Art Unit 3693
16 May 2008

/James A. Kramer/
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